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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,346

03/10/2004

Niu Dong

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09/04/2007

USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER
PATENT ADVISORS OFFICE
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EXAMINER

HAAS, WENDY C

ART UNIT

PAPER NUMBER

1661

MAIL DATE

DELIVERY MODE

09/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,346

Applicant(s)

DONG ET AL.

Examiner

Wendy C. Haas

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 10 is/are rejected.
- 7) ☐ Claim(s) 2, 3, 6, 11 AND 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>17 June 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-6 and 10-12 in the reply filed on 17 May 2007 is acknowledged. The traversal is on the ground(s) that there is no undue search burden on the Examiner to rejoin Groups I and II. This is not found persuasive because examination of Group II requires an additional, separate search. Should the elected claims be found allowable, the Examiner will rejoin the claims of Group II for examination.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The IDS filed 17 June 2004 has been considered.

Drawings

The drawings are approved.

Specification

The disclosure is objected to because of the following informalities: applicant must insert the SEQ ID numbers for the sequences supplied in the preliminary amendment into the correct location(s) in the Specification so that it is clear which SEQ ID number represents each sequence set forth.

Appropriate correction is required.

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Claim Objections

Claim Objections

Claims 1-6 and 10-12 are objected to because of the following informalities: claims 1, 4 and 10 are each missing a method step. Specifically, claims 1 and 4 state “until shoot formation occurs, thus creating transformed plantlets.” Applicant must include a rooting step for a complete plantlet to be disclosed, as tissue cultures frequently produce unrooted shoots that are not complete plantlets. Similarly, Claim 10 refers to “proliferation” of leaf strips, which also does not clearly set forth a method step that results in an entire plantlet. Claims 2 and 3 depend from Claim 1; Claims 5 and 6 depend from Claim 4; and Claims 11 and 12 depend from Claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Hallahan et al., US Patent Number 6,645,747.

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Hallahan et al. teach a method for transforming Dandelion leaf explants with *Agrobacterium* that comprises dipping sterile leaf explants into an *Agrobacterium* solution (see Col. 23, lines 34-47), then introducing the leaf explants to a nutrient subculture (see Col. 23, lines 50 to 60) under controlled light conditions (“cool white fluorescent lamps with a 16/8h light/dark photoperiod”) and then rooting the shoots into plantlets.

Hallahan et al. do not explicitly teach the claimed methods with respect to Guayule.

Hallahan et al. do teach that Guayule is a plant suitable for transformation with the methods disclosed. (see Column 14, lines 52-62.)

One of ordinary skill in the art would be motivated to transform Guayule with the claimed method because dipping leaf strips is an easier method to perform than the previous preferred method, inoculation of shoot explants, and because altering plants that product rubber and latex is desirable in the art. (See Col. 14, lines 35-40.) Accordingly, the claims would be *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Allowable Subject Matter

Claims 2, 3, 6, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claim is allowed. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wendy C. Haas/
Primary Examiner, AU 1661